

Remarks

Restriction/Election

This patent application contains claims 17-28, drawn to an invention nonelected with traverse in the Office Action dated September 14, 2005 (the "Present Office Action"). Applicant respectfully requests reconsideration of the restricted claims 17-28 in light of the remarks that follow.

In an Office Action dated June 13, 2005, the Examiner requested restriction of the claims to those in one of the groups designated by the Examiner as follows:

1. Restriction of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-16, drawn to a data processing system, performing an automated financial or business method, practice, or task, comprising a point-of-sale terminal having a specified transaction journal output feature (e.g., display prompt, printed receipt, voice output, etc.), classified in class 705, subclass 24.

II. Claims 17-28, drawn to a method of business, finance, or management comprising input to a point-of-sale terminal by product or record sensing, classified in class 705, subclass 23.

The Examiner then stated that claims 17-28 were directed to a separate invention for the reason that:

2. The inventions are distinct, each from the other because of the following reasons: Invention II is related to invention I, as process and apparatus for its practice. The inventions are distinct if it can be shown that *either*: (1) the process as claimed can be practiced by another, materially different apparatus, or by hand, *or* (2) the apparatus as claimed can be used to practice another, materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another, materially different apparatus, or by hand, such as with a point-of-sale system having no prompting system, the prompting instead being provided manually by a store point-of-sale system supervisor/attendant.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

In a Response to the Restriction Requirement from June 13, 2005, the Applicant elected, with traverse, Group I. The Applicant also amended independent claim 17 in Group II by clarifying that the recited prompting is provided “by use of the prompting system,” to clarify that both claims 1-16 (for a customer self-checkout system) and 17-28 (for a method of operation of a self-checkout system) of the above-referenced application claim a machine-operated prompting system, thereby forming one invention for a method and a system for its practice. The Applicant then submitted that amended claim 17, and its dependent claims 18-28, were no longer subject to being practiced by “another, materially different apparatus, or by hand” and, accordingly, the Examiner’s reason for restriction was no longer applicable.

In the Present Office Action, the Examiner rejected the Applicant’s arguments by stating that:

3. Regarding the argument that the particular example of distinctness cited by the examiner no longer applies, the argument is irrelevant, since the example provided was only was only exemplary, and other examples exist as well. Another example of distinctness would be that the apparatus as claimed can be used to practice another, materially different process, such as a process of checking out goods having no attached security tag to be deactivated.

Applicant respectfully submits that the Present Office Action does not state valid grounds for distinctness between Group I and Group II, by providing an impractical and trivial example of use of the invention. Additionally, the Present Office Action fails to show that the allegedly distinct inventions are not connected in either their design, operation, or effect wherein at least one invention is patentable over the other. Finally, the Present Office Action also fails to properly review all outstanding grounds for rejection.

As required by the MPEP § 706.07, “In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office Action contains a complete statement supporting the rejection.” Additionally, under MPEP § 802.01(II), “Related inventions are distinct if the inventions *as claimed* are not connected in at least one of **design, operation, or effect** (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is **PATENTABLE** (novel and nonobvious) over the other (though they may each be unpatentable over the prior art).” (Emphasis added). Finally, when requesting a restriction requirement on a process and apparatus for its practice (under MPEP § 806.05(e)), the Examiner has the burden, under the MPEP § 8.17, to provide “reasonable examples that recite material differences.” If the applicant “proves or provides convincing evidence that

there is no material difference or that a process cannot be performed by hand...the burden is on the examiner to document another materially different process or apparatus... .”

In the Office Action dated June 13, 2005, the Examiner’s requested restriction fails to recognize that the process/method claimed in Group II cannot be “practiced by another, materially different apparatus, or by hand, such as with a point-of-sale system having no prompting system, the prompting system instead being provided manually by a store point-of-sale system supervisor/attendant,” since both the application’s system/apparatus and process/method claims claim a “**self-checkout** system” comprising “a **self-checkout** station.” (Emphasis added). Therefore, the process/method and system/apparatus claims, *as claimed*, are not distinct in their operation, as illustrated by the Examiner in the Office Action of June 13, 2005. In the Present Office Action, the Examiner failed to carefully review and clearly develop this ground for restriction as required for the final rejection made in the Present Office Action, as the example brought by the examiner recites no “reasonable” or “material differences” between the application’s claimed system and method for its practice.

In the Present Office Action the Examiner attempts to illustrate, as required by the MPEP § 8.17, “another materially different process or apparatus.” However, the example provided by the Examiner fails to prove distinctness by showing that Group I and Group II, as claimed, are not connected in at least one of design, operation, or effect (as required by the MPEP § 802.01(II)), since both the system and method/process groups of claims can be used for primarily checking out goods having security tags as well as goods not having security tags. Also, the recited example of an apparatus that can be used to practice the process of “checking out goods having no attached security tags” provides an impractical, trivial and non-essential use of the invention which cannot render the recited distinct apparatus patentable over the application’s recited method, as required by the MPEP § 802.01(II).

Finally, to further elucidate the essence of the claimed system and method, independent claims 1, 16, and 17 were amended in this Response to make clear that both the application’s system and method claims are directed at a self-checkout system for checking out primarily goods having security tags attached thereto.

It is respectfully submitted that amended claims 1, 16, and 17 do not present distinct inventions under the MPEP § 802.01(II), § 806.05(e), and § 8.17. It is therefore respectfully requested that the Examiner withdraw the final Election/Restriction decision and allow the prosecution of Groups I and II together in the above referenced application.

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Drawings

In the Present Office Action, the Examiner objected to Figures 1B, 2A, 2B, 2C, and 3 as being black and white photographs which may only be submitted as provided by 37 C.F.R. § 1.84(b)(1) and §1.17.(i).

Applicant withdraws Figures 1B, 2A, 2B, 2C and 3 as objected to by the Examiner, and will submit amended drawings in compliance with 37 C.F.R. 1.84 to substitute the withdrawn photographs as soon as preparation of such drawings is completed.

Claim Rejections- 35 USC § 102

10. Claims 1-4 and 7-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mason (US 6,497,361). Mason discloses a customer self-checkout system for processing article purchases, the system comprising: a self-checkout station comprising: an input device configured to receive product code input designating an article for purchase; a deactivation device configured to produce a deactivation region affecting deactivation of a security tag attached to an article for purchase; and a prompting system configured to present a deactivation prompt to direct a user to position an article for purchase within the deactivation region to effect security tag deactivation.

The Examiner's rejection is respectfully traversed. It is well established that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Additionally, it is not enough that the cited reference discloses all the claimed elements in isolation, but the reference must disclose each element of the claimed invention "arranged as required by the claim." (MPEP § 2131). Contrary to the Examiner's assertion, the Mason reference clearly fails to disclose the prompting system element claimed in the present application, and any mentioning of prompting in the cited reference is disclosed in isolation and is not directed to the structure of the present application.

Claim 1 of the present application has been amended to recite a customer self-checkout system for processing article purchases that is directed to process purchases of articles normally having a security tag attached thereto, comprising of an input device configured to receive product code input designating an article for purchase; a deactivation device configured to produce a deactivation region effecting deactivation of a security tag attached to an article for purchase; and a prompting system configured to present a deactivation prompt to direct a user to position an article for purchase within the deactivation region to effect security tag deactivation. The claim clarifies that the prompting system is configured specifically to direct a user to a desirable positioning of the article for purchase within the deactivation region, to effect security tag deactivation. The disclosed prompting system of claim 1 is aimed to facilitate reliable and easy-to-operate deactivation of security tags attached to articles for purchase by providing clear prompts to the purchasing customer to effect manual intervention in the deactivation

process. Examples of such prompts are specifically disclosed and illustrated, for example, in figures 2A, 2B, 2C, and 3 in the present application.

In contrast, Mason does not teach any such prompting system. Contrary to the Examiner's assertion, the Mason reference does not describe a prompting system, and in fact mentions the word "prompt" or its derivatives only twice, in connection with prompting a customer to initiate self-checkout by sweeping his or her credit card (in column 2, line 60), or prompting a customer to move a scanned article, from the scanning and deactivation area after deactivation of the tag, to the "itemized area" (i.e., packaging area) (in column 4, line 19). These are courtesy prompts that are unrelated to the claimed interactive prompts of applicant's claims. Anti-theft tag deactivation in the Mason reference is automated and done with no prompting and manual intervention by a customer. In fact, Mason specifically contemplates a combined automated scanning and deactivation process by attachment of the anti-theft tag in a certain location on the article for purchase relative to the a article's bar code or other identifying mark. (See, Mason Column 3, lines 16-30 and Figures 3, 4).

Claims 2-4 and 7-15 depend, directly or indirectly, on claim 1 and are patentable over Mason for at least the reasons stated with respect to claim 1.

Claim 3 of the present application also teaches a target visibly disposed proximate the deactivation region at the checkout station, wherein the second prompt instructs the user to move the article to touch the target to effect security tag deactivation. Further contrary to the Examiner's assertion, the system in Mason does not include a target visibly disposed proximate to the deactivation region, and it also does not include a second or any prompt to instruct or facilitate tag deactivation. Instead, the deactivation area in Mason is not separated or distinguishable from the scanning area, with both scanning and deactivation occurring automatically and without any prompts in the same area. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 3's prompting system is found.

Claim 4 of the present application also teaches a prompting system configured to present the deactivation prompt to a user after receipt of a product code by the input device. Further contrary to the Examiner's assertion, Mason does not and cannot teach a system that presents a deactivation prompt to a user before or after receipt of a product code by the input device, since no such deactivation prompt exists in the automatically operated deactivation system taught by Mason. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 4's prompting system is found.

Claim 7 of the present application also teaches a sensor for sensing the presence of an article within the deactivation area. Further contrary to the Examiner's assertion, Mason does not teach a sensor that is dedicated to sensing the presence of an article within the deactivation area, since Mason does not teach a dedicated deactivation area where a special sensor may be located to perform certain functionalities specifically related to tag deactivation. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 7's prompting system is found.

Claim 8 of the present application also teaches a scale operatively coupled to the prompting system, wherein the scale communicates with the prompting system to provide a deactivation prompt when a weight change is detected by the scale and the sensor of the deactivation area has not sensed the presence of the weighed article within the deactivation area. Further contrary to the Examiner's assertion, Mason does not teach a prompting system coupled to a scale for assisting error-free deactivation. In contrast, Mason's scale is used only to provide an additional parameter to determine the identity of scanned articles for purchase. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 8's prompting system is found.

Claim 9 of the present application also teaches a prompting system configured to present a prompt providing instructions to a user to place an article for purchase into a bag on the bagging platform. Further Contrary to the Examiner's assertion, Mason does not teach any such prompting system or specific prompt. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 9's prompting system is found.

Claim 10 of the present application also teaches a bagging platform having a bag holder adapted to hold a bag for receiving articles. Contrary to the Examiner's assertion, Mason does not teach any such bag holder for receiving articles. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 10's prompting system and bagging platform are found.

Claim 11 of the present application teaches a prompting system configured to present a feedback prompt to confirm deactivation of the security tag after the sensor of the deactivation area senses presence of an article within the deactivation area. Contrary to the Examiner's assertion, Mason does not disclose any such prompting system, a feedback prompt, or a dedicated sensor for sensing the presence of an article within the deactivation area. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 11's prompting system is found.

Claim 12 of the present application teaches a feedback prompt that further prompts a user to put an article for purchase in a bag. Contrary to the Examiner's assertion, Mason does not teach any feedback prompt that instructs a user to put an article for purchase in a bag. The Examiner is respectfully requested to identify where in the Mason Reference a teaching of the present application's claim 12's prompting system is found.

[discuss claim 13. Note Mason in column 2, line 19-25].

[discuss claims 14-15].

For at least the reason that Mason fails to disclose or suggest one or more elements of claims 1-4 and 7-15, the Examiner's rejection of these claims for anticipation under 35 U.S.C. §102 in light of Mason is improper and should be withdrawn. Accordingly, it is respectfully requested that the Examiner withdraw his rejection and allow claims 1-4 and 7-15.

Claim Rejections- 35 U.S.C. § 103

12. Claims 5, 6, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over mason (US 6,497,361).

Mason discloses a customer self-checkout system for processing article purchases, as applied above in the rejection of claims 1 and 4 under 35 U.S.C. 102(b), but Mason fails to disclose that the database system coupled to the self-checkout station and comprising stored data identifying articles having attached security tags also stores data on articles not having attached security tags to determine whether an article designated by the received product code input has an attached security tag; and wherein the prompting system is configured to present the deactivation prompt when the article has an attached security tag and to not present the deactivation prompt when the article does not have an attached security tag, the system of Mason presenting the deactivation prompt when the stored data associated with an article does not indicate whether said article has an attached security tag or not, since the system of Mason seems to assume that all items in the store would have a security tag needing to be deactivated.

However, it is well known to those of ordinary skill in the art, that, ordinarily, due to the cost of the security tag, not all items in a store are provided with a security tag, and it would be self-evident/inherent that

items not having security tags would not need to have a security tag deactivated.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Mason so as to use store in the database of item weights, an indication as to whether or not each item is protected by a security tag, and to only deactivate tags for items that have such tags, as is well known to do, in order to accommodate stores having a mix of inventory partially protected by security tags and partially not protected by security tags, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected result.

The Examiner's rejection of claims 5, 6, and 16 under 35 U.S.C. § 103 as unpatentable over Mason is respectfully traversed.

It is well established that, to establish a *prima facie* case of obviousness, the Examiner must show, among other things, that the prior art reference teaches or suggests all the claim limitations in the rejected application. Additionally, the Examiner must consider the present application from the point of view of a person of ordinary skill in the relevant art when the claimed invention was unknown, and put aside current knowledge of the present application. *See*, the MPEP § 2142. s

As explained *supra*, with respect to the Examiner's rejection of claims 1-4 and 7-15 under 35 U.S.C. § 102 in light of Mason, Mason fails to disclose or suggest one or more elements of each of the rejected claims (e.g., elements of a prompting system configured to provide a deactivation prompt to direct a user to move an article for purchase within the deactivation region to effect tag deactivation). In contrast, claims 5, 6 and the amended claim 16 of the present invention teach a self-checkout system which includes, among other elements, the prompting system described *supra*. Because Mason simply fails to disclose or suggest all the elements of the claims (as required by the MPEP § 2142), the rejection under 35 U.S.C. § 103(a) is not supported and is improper.

Moreover, the Examiner's rejection is merely an application of hindsight reasoning, unsupported by any objective evidence which may provide a sufficient basis to reject the claims. While asserting that it would be inherent/self-evident that articles not having security tag would not need deactivation, the Examiner has not provided any objective evidence, outside the present application, of such "self-evident" method. In fact, Mason's disclosure of deactivation of all articles for purchase and irrespective of whether or not such articles have a security tag does not provide any evidence that selective deactivation

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was self-evident under Mason, and instead indicates that Mason did not consider selective deactivation and selected a non-selective constant deactivation without considering the presence of security tags on certain articles for purchase.

Conclusion

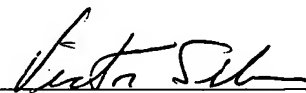
For the foregoing reasons, allowance of this application, as amended, is courteously urged. Amended claims 1 and 16, and claims 2-15 are now pending and believed to be in condition for allowance. Additionally, withdrawn and amended claim 17, and claims 18-28, are also believed to be in condition for allowance. Applicants respectfully requests that all pending and withdrawn claims be allowed.

If there remain any questions regarding the present application, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact the undersigned at (212) 878-8429 in order for the undersigned to arrange for an interview with the Examiner.

Please charge any additional fees for this Amendment or credit any overpayments to Deposit Account No. 50-0521.

Respectfully submitted,

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